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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/608,321	06/27/2003	Gregory Swab	881987-17	8723
29619	7590	07/27/2004	EXAMINER	
SCHULTE ROTH & ZABEL LLP ATTN: JOEL E. LUTZKER 919 THIRD AVENUE NEW YORK, NY 10022			ORTIZ, ANGELA Y	
			ART UNIT	PAPER NUMBER
			1732	

DATE MAILED: 07/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

S.C.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/608,321	SWAB ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Angela Ortiz	1732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 May 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date: _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date: _____  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Specification***

The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01. See paragraph [0005, 0007, 0032], as an example, of the instant specification.

The use of the trademark BLUETOOTH has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

The abstract of the disclosure is objected to because it exceeds 150 words. Correction is required. See MPEP § 608.01(b).

Applicant should amend paragraph [0001] to correctly refer to application 09/845,425; note that the patent application transmittal incorrectly identified the parent application, but the oath correctly identifies the parent application.

### ***Claim Objections***

Claims 1-8 are objected to because of the following informalities: the use of the trademark BLUETOOTH has been added to the claims, and must be deleted; it can not

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be claimed, but may be replaced by its generic terminology. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 contains the trademark/trade name BLUETOOTH. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a radio transceiver and an ad hoc wireless network and, accordingly, the identification/description is indefinite.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over De Angelis, USP 2,794,085 in view of Fila et al., USP 3,853,393, further in view of Haken, USP 6,629,076.

The cited primary reference substantially teaches the basic claimed process of manufacturing eyewear comprising a plastic frame and plastic temples, the frame and temples removably connected via a hinge, and electrical components of an apparatus in the temple. Plural conductors are provided in the temple and frame, having an electrical connection with the components. A connecting hinge through female/male attachment means connects the frame and temples. The device is useful as a hearing aid, which includes means readable on an ear bud. See col. 3, lines 32-75; col. 4, lines 45-70; col. 5, lines 30-75.

The primary reference is silent to the step of molding as claimed; however, it does set forth that the temples and frame are formed.

The added secondary reference teaches as conventional the process of injection molding plastic eyewear temples, wherein conductors are encapsulated within the temples. The molded temples house hearing aid components, and are molded of conventional plastic materials using conventional molding means. See col. 3, lines 10-40, 54-65.

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to mold the plastic temples and frame, in view of the molding process set forth in the added reference, when performing the process set forth in the added reference, for achieving the desired step of forming the plastic eyewear.

The previous art combination does not set forth a radio transceiver and ad hoc wireless network as claimed.

The added reference sets forth as conventional eyewear with means for hearing and aiding speech. The eyewear includes embedded microphone, processor and battery, readable on the claimed radio processor, which forms an ad hoc wireless network with a plurality of devices. See col. 1, line 60 to col. 2, line 25; col. 2, lines 37-60.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a radio transceiver and ad hoc wireless network as shown in the added reference, when performing the process set forth in the previous art combination, for improved means for aiding and hearing speech.

With respect to claims 6 and 8, see col. 3, lines 5-25 of the Haken reference.

### ***Response to Arguments***

Applicant's arguments filed 14 May 2004 have been fully considered but they are not persuasive.

Applicant has amended claim 1 to include previously claimed subject matter from claim 5. Note that the previously applied rejection of claim 5 is now applied to claim 1.

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It appears that applicant has inserted a portion of a limitation held allowable from the allowed product into the method claims; however, the use of BLUETOOTH is a trademark and cannot be inserted within the claims. It is anticipated that the applicant will insert the generic terminology, namely radio transceiver and an ad hoc wireless network as previously set forth in claim 5, and thus the previous rejection as applied to claim 5 is now applied to claim 1.

Applicant argues that the art does not teach co-molding the transceiver, namely the reference to Haken. Applicant further argues the communications device 34 creates an ad hoc network.

The use of the term co-molding, in light of the specification, appears to mean encapsulating. Note that the prior art combination, particularly the primary and secondary reference, sets forth encapsulated conductors in the eyewear, and is combinable within the field of molding eyewear with embedded electrical means. Note that the transceiver 18 of the instant specification is connected to electrical means and is embedded in the frames. While the transceiver is desired to be ad hoc, this limitation is deemed an intended use, and does not differentiate the method of molding eyewear manipulatively. The prior art combination is readable on claim 1 as amended.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

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Applicant must use language in the claim to show how the method incorporating the transceiver/network specifically, positively and manipulatively overcomes the applied method of molding an embedded apparatus within a plastic frame, as shown in the prior art.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Search results on BLUETOOTH from US Trademark Electronic Search System.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.



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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Angela Ortiz whose telephone number is 571-272-1206. The examiner can normally be reached on Monday-Thursday 9:00-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Colaianni can be reached on 571-272-1196. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Angela Ortiz  
Primary Examiner  
Art Unit 1732

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